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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,694	04/06/2001	Erwin Hacker	514413-3866	7835

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

CLARDY, S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 05/07/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/762,694

Applicant(s)

Hacker et al

Examiner

S. Mark Clardy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 7, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-47 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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Claims 21-47 are pending in this application has been filed under 35 USC 371 as a national stage application of PCT/EP99/05799, filed August 10, 1999. This application possesses unity of invention under 37 CFR 1.475 (MPEP 1850, 1893.03(d)).

Applicants' claims are drawn to herbicidal compositions (claims 30-35), and methods of use *< in sugar beets* (claims 21-29, 36-47), comprising:

A. One or more herbicidal agents selected from:

1. Phosphinothricin derivatives: bilanafos or glufosinate (A1.2)
2. Glyphosate (A2.2)
3. Imidazolinones

B. An additional herbicidal agent¹:

1. Ethofumesate (B1.1), chloridazon, triflurosulfuron (B1.3), metamiltron (B1.4)
2. Desmedipham (B2.1), phenmedipham (B2.2), quinmerac (B2.3), clopyralid (B2.4)
3. Quizalofop, fenoxaprop (B3.2), fluazifop, haloxyfop (B3.4), cyhalofop
4. Sethoxydim (B4.1), cycloxydim (B4.2), clethodim.

The data presented in the specification demonstrates synergistic effects for several combinations of A1 or A2 with specific additional herbicidal components. No test data has been presented for the imidazolinones (A3).

Note that the term haloxyfop-P has been misspelled in claim 21, part B3 (not claim 23).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment

¹Excluded: A1 or A2 + propaquizafop or clodinafop;
A2 + triflurosulfuron, metamiltron, chloridazon, quizalofop, fluazifop, sethoxydim, clethodim, or clopyralid

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by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321c may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 30-35 are provisionally rejected under the judicially created doctrine of double patenting over claims 33, 34, and 44 of copending Application No. 09/762,673, and claim 20 of Application No. 09/371,612. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending applications and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: identical A and B components as outlined above.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending applications. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 21, 23-31, 33, 35, 45, 47 are again rejected under 35 U.S.C. 102(a) and (e) as being
no prior art: 30, 31, 33, 35
anticipated by Flint et al.

Flint et al, again, teach the combination of glyphosate with several of applicants' secondary herbicides (columns 4-6, e.g., claim 1 or col 4, lines 8-15: sethoxydim, clethodim, quizalofop, fluazifop, fenoxaprop, imazamox, imazethapyr, imazaquin) for use in controlling weeds and volunteer crop plants in transgenic glyphosate resistant crops, including sugarbeets (col 6, lines 58-65). Additional adjuvants are disclosed in column 4. Applicants assert that Flint teaches against the combinations having synergistic activity, quoting the paragraph beginning at column 7 (not 4), line 40, in which antagonism is mentioned as a possible occurrence if two herbicides are combined. However, in the following paragraph, it is stated that "antagonism is unlikely in light of the present disclosure", and proceeds to explain why, given different mechanisms of action, that mixtures of glyphosate and non-glyphosate herbicides can be used without concern for antagonism. Note that it appears that applicants' proviso statements should include fenoxaprop in view of the teaching at

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col 4, lines 8-15, in which this secondary herbicide is mentioned as one of the preferred herbicides to combine with glyphosate (applicants' A2+B3).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-47 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Flint et al in view of Novartis (PCT WO 98/09525; reference AB, IDS Paper No. 7).

Flint et al has been discussed above, and discloses applicants' compounds and the method of treating weeds in glyphosate resistant crops with compositions comprising glyphosate and the secondary herbicides claimed herein.

Novartis teaches the utility of phospho-herbicides such as glufosinate and glyphosate in synergistic combination with additional herbicidal agents for the control of weeds in phospho-herbicide resistant crops (p. 1). Specifically disclosed secondary herbicides are (abstract): prosulfuron, primisulfuron, dicamba, pyridate, dimethenamide, metolachlor, fluometuron, propaquizafop, atrazine, clodinafop, norflurazon, ametryn, terbutylazine, simazine, prometryn, and four additional agents (NOA-402989 and compounds I-III).

One of ordinary skill in the art would be motivated to combine these references because they disclose a variety of herbicides which may be used in combination with others for weed control in

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herbicide resistant crops. Specifically, glyphosate is shown in both references to be useful in combination with secondary herbicides for the control of glyphosate resistant weeds (i.e., unwanted volunteer crop plants) among other glyphosate resistant crops.

Thus it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have combined glyphosate and the secondary herbicides because it was known to add such secondary herbicides to glyphosate compositions for the control of volunteer, glyphosate resistant crop plants in other glyphosate resistant crops. Further, it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 205 USPQ 1069.

Applicants have presented data demonstrating slight (93% vs 95%) to significant (55% vs 96%) synergistic effect for various glufosinate and glyphosate compositions. However, in view of the teachings of the prior art, such synergistic effect would appear to be expected. Comparisons with the closest prior art would appear to be indicated. An evaluation of an invention's nonobviousness must compare the claimed invention with the closest prior art in order to be meaningful; otherwise, there is no basis for relating the claimed invention to the prior art in order to conclude whether or not it is unexpectedly superior and therefore unobvious. In re Wood and Eversole, 202 USPQ 171.

Further, objective evidence of nonobviousness must be commensurate in scope with the scope of the claims. In re Tiffin, 171 USPQ 294. Applicants have presented data only for

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glufosinate (A1.2) and glyphosate (A2) compositions; data for compositions comprising the other
A component herbicides should be provided.

No claim is allowed.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is (703) 308-4550.



S. Mark Clardy
Primary Examiner
AU 1616

May 5, 2003